E4

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,558	01/18/2001	Vincent P. Annunziata	03169- P0003B	6841

24126 7590 06/02/2005

ST. ONGE STEWARD JOHNSTON & REENS, LLC
986 BEDFORD STREET
STAMFORD, CT 06905-5619

EXAMINER	
KYLE, CHARLES R	

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/764,558	ANNUNZIATA, VINCENT P.	
	Examiner	Art Unit	
	Charles Kyle	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/12/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 9-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,136,501 *Silverman et al* in view of US 4,266,775 *Chitnis et al.*

With respect to Claim 1, *Silverman* discloses the information substantially as claimed, including in a system for trading of commodities (Col. 20, line 58 to Col. 21, line 29) comprising elements of:

a computer accessible by a plurality of traders over a computer network (Fig. 2, ele.20);

a database accessible by said computer containing a plurality of indications submitted by traders of the system to said computer over said computer network, wherein each of said plurality of indications relates to a bid or offer for a specified number of units of a specified commodity at a specified unit price (Figs. 4 and 5, Col. 10, line 54 to Col. 11, line 14.);

an indication selected from said plurality of indications submitted by a trader to said computer over said computer network (Fig. 17, 139.19 Bid for 10 units) ; and,

software executing on said computer for receiving said selected indication

from the trader (Background Art), updating said listing of commodities and units thereof in said retrieved player portfolio to reflect said selected indication (Fig. 17, 139.19 Bid for 10.0 units matched to 139.19 Offered as 6.0 and 3.0 units), updating said money value in said retrieved trader portfolio to reflect said selected indication, and removing the selected indication from said indication database (Fig. 18, previously Bid and Offers removed; 1.0 units leaves at 139.19).

Silverman does not specifically disclose a database accessible by a computer containing a plurality of trader files associated with a plurality of traders of the system wherein each of said plurality of trader files contains a portfolio containing a score associated with a specific trader and related portfolio manipulations during trading. Official Notice is taken that it was old and well known to maintain records of trader holdings, (i.e., a portfolio), and to manipulate them in the claimed ways. For example, such a portfolio of commodity holdings would be necessary for a trader/player to know what his/her assets were. Retrieval and updating of a portfolio were old and well known portfolio accounting processes. Further, the accumulated portfolio value would constitute a score, as money can be considered the ultimate score-keeping device. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Silverman* with these old and well known portfolio management and valuation processes to provide timely, accessible records of trader/player holdings. See also *Chitnis* at Abstract where a winner is determined based on highest money score.

While commodities trading is recognized to be a competitive "game", *Silverman* does not specifically disclose that his trading is a game. *Chitnis* discloses that such trading is presented in the form of a game at Abstract, at least. It would have been obvious to one of ordinary skill in

the art at the time of the invention to modify the trading disclosed by *Silverman* to be in a game format because this would make an educational presentation for persons learning trading. See *Chitnis* at Col. 1, lines 7-10.

With respect to Claims 2 and 3, Official Notice is taken that it recites old and well-known elements of games rules, scoring and termination. For example, some form or scoring is essential to any game; winner determination and game and are likewise essential. In the particular environment of a trading game, the use of an accumulated portfolio valuation would be analogous to accumulated cash in a game such as Monopoly TM. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Silverman* to include such game functions to facilitate the practice of trading a s a game.

Concerning Claim 4, *Chitnis* discloses a preset time period at Abstract. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify a game based on the trading of *Silverman* to have a predetermined end point as in *Chitnis* because this would increase trading intensity for traders/players.

With respect to Claim 5, *Silverman* does not determine a predetermined trader/player score to end trading. Official notice is taken that it is old and well known that he who dies with the most money wins. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify a game like instantiation of *Silverman* to end at a particular score, such as money, because this provides a known and convenient metric for identifying a winner.

With respect to Claim 9, *Silverman* discloses order (bid/offer) entry at Col. 7, lines 2-13 and confirmation of sufficient financial resources at Col. 18, line 10 to Col. 19, line 68. Some type of form is inherent to computer data entry.

Concerning Claim 10, see the discussion of Claim 9. Official Notice is taken that it was old and well known to verify that a trading party had sufficient commodity units to sell in a way analogous to verifying sufficient funds to buy, as is the discussion of Claim 9. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide such verification in *Silverman* to assure that a party had sufficient units to sell for a particular transaction.

With respect to Claim 11, *Silverman* discloses rejection of an indication violating rules at Col. 17, lines 7-18.

Concerning Claim 12, *Silverman* discloses transmission and presentation of indications at Col. 2, lines 18-63.

With respect to Claim 15, *Silverman* discloses content selection corresponding to indications and receiving these at Col. 6, line 22 to Col. 8, line 30.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,136,501 *Silverman et al* in view of US 4,266,775 *Chitnis et al* and further in view of *Dictionary of Finance and Investment Terms*, hereinafter *Dictionary*.

With respect to Claim 6, *Silverman* discloses the invention substantially as claimed. See the discussion of Claim 2. *Silverman* does not specifically disclose beginning trading with predetermined limitations on a trader/player's open position. *Dictionary* discloses such

limitations at pages 456-457, "Position Limit." It would have been obvious to one of ordinary skill in the art at the time of the invention to modify a game like instantiation of *Silverman* to include the position limitations of *Dictionary* because this would provide an accurate representation of regulations affecting trading in real commodities markets. *Chitnis* discloses beginning with an empty portfolio at Col. 3, lines 28-37.

With respect to Claim 7, see the discussion of Claim 6. It would have been obvious to one of ordinary skill in the art at the time of the invention to make limitations effective at game end to assure that a player's final position complied with those limitations.

With respect to Claim 8, as cited above *Chitnis* allows players top begin with cash; commodities in *Chitnis* are predetermined to be zero, a trivial case, which nonetheless meets the limitation.

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,136,501 *Silverman et al* in view of US 4,266,775 *Chitnis et al* and further in view of US 4,677,552 *Sibley, Jr.*

As to Claims 13 and 14, *Silverman* discloses the invention substantially as claimed. See the discussion of Claim 2. *Silverman* does not specifically disclose formatting and sorting of a presentation (display). *Sibley, Jr.* discloses these limitations at Col. 10, lines 42-66. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Silverman* with the formatting and sorting of a presentation (display) of *Sibley, Jr.* because this would allow a trader/player to design a display most accessible to himself.

Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,136,501 *Silverman et al* in view of US 4,266,775 *Chitnis et al* and further in view of US 6,745,236 *Hawkins et al.*

As to Claim 16, *Silverman* discloses the invention substantially as claimed. See the discussion of Claim 1. *Silverman* does not specifically disclose details of trader/player registration. *Hawkins* discloses registration forms at Col. 17, lines 25-31. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Silverman* to have registration forms and function to control access to a trading game.

As to Claim 17, *Silverman* discloses the invention substantially as claimed. See the discussion of Claim 1. *Silverman* does not specifically disclose playing a game on the Internet. *Hawkins* discloses this limitation at Background of the Invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Silverman* to function on the Internet because this would provide a broad accessible playing area for trader/players.

Response to Arguments

Applicant's arguments filed March 7, 2005 have been fully considered but they are not persuasive.

Applicant argues two premises at pages 9-11 of the Remarks. Specifically, Applicant argues against the Examiner's taking of Official Notice for the second and third phrases in the body of Claim 1. First, Applicant argues at page 9, second paragraph, that it was not known in the trading arts to provide a central database containing information of traders' holdings in commodities and units thereof and a money value. Applicant makes this assertion but provides

no evidence that such a central database is new. In support of this taking of Official Notice for this limitation, the Examiner offers US 6,601,044 *Wallman,* which shows that these features were old and well-known at the time of the invention including a central database containing information of traders' holdings in commodities and units thereof and a money value. See *Wallman* at Figs. 6, 10, 11-13 and related text.

At page 9, last paragraph, onto page 10, Applicant argues the limitation of files containing a score based on a portfolio, the score determined by a computer. Applicant is correct that the '501patent does not teach a score determined by a computer; the Examiner relied on the taking of Official Notice to address this limitation, stating that accumulated portfolio value would constitute a score, and money can be considered the ultimate score-keeping device. Applicant fails to address this treatment of the Claim limitation. It is inherent that accumulated portfolio balance would be kept on a computerized trading system for speed and accessibility. Applicant argues that determination of a winner is not disclosed by the '501 patent, but does not address the Examiner's treatment of the limitation in the rejection of Claim 2.

At page 10, second full paragraph and page 11, Applicant restates the two arguments addressed above.

At page 10, last paragraph, Applicant argues that there is no suggestion in the cited prior art to combine the references. In response to this argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re*

Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner has provided a reasoned argument for combination at the last paragraph of the rejection of Claim 1; Applicant does not address this reasoning. Restating the reasoned argument, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the trading disclosed by *Silverman* to be in a game format because this would make an educational presentation for persons learning trading. See *Chitnis* at Col. 1, lines 7-10.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (571) 272-6746. The examiner can normally be reached on 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Crk
May 31, 2005

Examiner Charles Kyle